

REMARKS

Claims 1-10 remain pending in this application for which applicant seeks reconsideration.

Amendment

Independent claims 1 and 8 have been amended further improve their clarity and to overcome the § 101 rejection (claim 8). Claim 8 now recites that management unit carries out the method steps, namely tying the method steps to particular structure. The updating unit corresponds to part of the controller 101 (see Fig. 2), which is configured to carry out a particular function (see S1506 in Fig. 16), namely by the license management module 503 (see Fig. 5), as disclosed in paragraphs 111, 114, 115 of corresponding USPGP 2004/0205261. No new matter has been introduced.

Objection to the Specification

The examiner objected to the specification because the original specification allegedly does not define "comparison unit," "start program management unit," "storage unit," "setting instruction" (was revised previously - no longer recited in claim 9), "license management unit," and "license information acquisition unit." The specification does not have to recite these elements in verbatim. Rather, the specification merely needs to reasonably convey to one of ordinary skill in the art what the claimed elements refer to. Note, however, that there is no requirement anywhere that the written description or support requirement must be satisfied exclusively from the written part of the specification. Drawings alone can provide support and satisfy the written description requirement.

Note that when a controller or computer is programmed to perform particular functions, it becomes a specialized device, the functionality of which can be expressed as a device or means-plus-function limitations. In claim 1, for instance, the particular functions carried out by the controller are expressed in terms of devices, namely units. In this respect, the comparison unit is part of the controller 101 corresponding to the functionalities performed by the license management module 503 (Fig. 5), which corresponds to the license management unit. See at least S1503, S1504 in Fig. 16 and Fig. 6 and paragraphs 113, 114.

The start program management is also part of the controller 101 corresponding to the functionalities performed by the start program identification module 502 (see Fig. 5) and disclosed in paragraph 72. The license information acquisition unit is also part of the controller 101 corresponding to the functionalities performed by the license management module 503.

See at least S1405 in Fig. 15 and paragraphs 107, 108, 111. The storage unit corresponds to at least the ROM 203 or DISK 204. See paragraphs 63, 83. Applicant submits that the original specification provides adequate defines the claimed terminologies.

Art Rejection

Claims 1-6 and 8-10 remain rejected under 35 U.S.C. § 102(b) as anticipated by Nakamura (USPGP 2002/0143568), and claim 7 remains rejected under 35 U.S.C. § 103(a) as unpatentable over Nakamura in view of Quistgaar (USPGP 2003/0009102).

Applicant previously explained that even if Nakamura were able to set the activated trial program to be executed at the start of its image forming apparatus for argument's sake, Nakamura still would not have disclosed or taught (1) comparing the program specifying information with the start program identification information when (a) the apparatus specifying information included in the acquired license information and the stored apparatus identification information match, and (b) the program specified by the program specifying information included in the license information is identical to any of the programs, and (2) changing [updating as presently amended] the start program identification information corresponding to the program specified by the program specifying information to be executed at the start of the image forming apparatus, when the program specified by the program specifying information has not been set to be executed at the start of the image forming apparatus as the result of comparison.

Regarding feature (1) above, the examiner alleges that at least Nakamura's paragraphs 9, 11, 41, 87, 91, 98, and Fig. 8 disclose the claimed feature. Moreover, the examiner further argues that Nakamura's Fig. 9 and paragraph 52 disclose the claimed matching feature. Nakamura's Fig. 9 and paragraph 52, however, have nothing to do with starting up a program at the start of the image forming apparatus. Rather, they merely refer to when the user manually inputs via the operational panel 23 after the image forming apparatus has been fully started.

On this point, the examiner further argues that the operation following "when" is merely optional and thus need not be considered, relying on MPEP § 2106 II C. Applicant disagrees. MPEP § 2106 II C states that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The claimed limitation associated with "when" is a required element, and not an optional element. Rather, it is a qualifier that describes the operational and functional characteristics of the claimed element, and thus cannot be ignored. Indeed, MPEP § 2106 II C requires **"when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete**

elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered."

Moreover, the examiner asserts that the claimed language, namely "that stores," "that permits," and "that acquires," etc., is directed to intended use. Again applicant disagrees because the examiner provides no basis for why the examiner has construed the claims in this manner. Rather, the examiner appears to be merely dismissing the claimed limitations for the convenience sake of not having to specifically address the claimed limitations in rejecting the claims.

The claimed language at issue is a limitation that describes operational and functional characteristics of the claimed element. Moreover, a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP § 2173.05(g). Moreover, the claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art. Note also that the functional characteristic of the language at issue is needed to give life and breadth to the claimed limitations. It simply is improper for the examiner to ignore the claimed limitations.

Regarding feature (2) above, the examiner alleges that at least Nakamura's paragraphs 11, 87, and 98 disclose the claimed feature. Applicant again disagrees. These paragraphs merely relate to the input-matching feature when the user manually inputs a key. These paragraphs have nothing do with changing the start program identification information as set forth in the independent claims.

Quistgaard, which was merely relied upon for the encrypting aspect, discloses a portable handheld ultrasound instrument performing both of B-mode image processing and Doppler image processing, while upgrading software and data of measuring instrument to an updated version or a modified version, using an encrypted keycode. Quistgaard would not have alleviated Nakamura's shortcomings noted above even if the combination were deemed proper for argument's sake.

Conclusion

Applicant submits that claims 1-10 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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DATE

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